

REMARKS

Informalities.

Substitute Specification. Applicant respectfully submits a substitute specification to replace that originally submitted. Several insignificant changes have been made to the specification to correct various typographical errors found therein. Applicant submits that no new matter is presented, and that the replacement specification conforms to and is submitted pursuant to 37 C.F.R. § 1.125.

Claim Objections.

Claims 9-16 were objected to as each recites or depends from a claim which fails to capitalize the genus "Morinda" in the term "Morinda citrifolia." Claims 9-17 have been amended to correct this deficiency.

Additionally, claim 13 was objected to due to a grammatical error. Claim 13 has been amended to correct this deficiency.

Claim Rejections under 35 U.S.C. § 112.

Claims 9-17 stand rejected under 35 U.S.C. § 112, second paragraph ("Section 112") as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant has amended the claim set according to suggestions set forth by the Examiner. Each amendment finds support in the specification originally filed and thus adds no new matter. Specifically, Applicant's incorporation of the limitation "a remaining substantially non-aqueous portion of said Morinda citrifolia slurry" in claim 9 finds support at page 13, lines 2-4 and page

16, lines 13-20.

Applicants respectfully submit that the amendments made to the claim set overcome the rejections made by the Examiner under Section 112, second paragraph. Accordingly, Applicants respectfully request withdrawal of the rejections of claims 9-17 under Section 112, second paragraph.

Claim Rejections under 35 U.S.C. § 103.

Claims 9-11 and 14-16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Pat. No. 4,463,025 to Strobel ("Strobel") in view of an article entitled "Morinda Achieves Phenomenal Sales of Tahitian Noni Juice", published in Kuala Lumpur in 1999 ("Lumpur") and U.S. Pat. No. 6,254,913 to Wadsworth ("Wadsworth").

An invention is unpatentable under 35 U.S.C. § 103(a) ("Section 103") "if the differences between the subject matter sought to be patented over the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains."

To establish a *prima facie* case of obviousness, three criteria must be met. "First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2142.

Claim 9, as amended, recites "freezing, at a first temperature, a Morinda citrifolia slurry to effectuate a separation of substantially pure water as ice crystals from said Morinda citrifolia

slurry." Claim 9 also recites "freezing, at a second temperature, a remaining substantially non-aqueous portion of said *Morinda citrifolia* slurry [and] recovering . . . concentrated *Morinda citrifolia*." Similarly, claim 17, as amended, recites "[a] *Morinda citrifolia* concentrate resulting from concentrating, by freeze concentration, a *Morinda citrifolia* slurry." These amendments add no new subject matter as they are sufficiently disclosed by the specification originally filed. See Specification, p. 16-17. Applicant finds no mention or suggestion of these elements in the cited references, nor any equivalent thereof.

Indeed, Strobel discloses a process for preparing a natural citrus fruit concentrate comprising concentrating, by freeze concentration, a serum portion of the fruit juice. See Strobel, col. 8, ln. 22-23. Strobel neither teaches nor suggests concentrating, by freeze concentration, a juice slurry containing both serum and particulate solids, as disclosed by the present invention. As the cited references fail to teach each and every element of the present invention, the present invention is not obvious in light of such references.

Further, "the omission of an element and retention of its function is an indicia of unobviousness." MPEP § 2144.04(II)(B). The present invention, like Strobel, teaches recovering a fruit concentrate but, unlike Strobel, does not require initial separation of the fruit juice into serum and pulp. Likewise, the present invention does not require subsequent addition of the pulp to the concentrate, as does Strobel. The function of the separation and recombination steps taught in Strobel is to create a concentrate while preserving the low boiling aroma and flavor compounds present in the particulate-containing fruit juice. The present invention accomplishes the same purpose while omitting the steps of separation and recombination. The present invention is thus not rendered obvious by Strobel for at least this reason.

As claims 10-16 depend from otherwise allowable subject matter, these claims are also not rendered obvious by the cited references under Section 103.

Accordingly, Applicant respectfully requests withdrawal of the rejections of claims 9-17 under Section 103.

Conclusion

Based on the foregoing, Applicant believes that the claims of the present invention are in condition for allowance and respectfully requests the same.

Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to initiate a telephone interview with undersigned counsel.

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Respectfully submitted,

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